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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/633,911	08/08/2000	Daniel J. McGurran	55282USA1B.010	4870

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EXAMINER

PAULRAJ, CHRISTOPHER

ART UNIT PAPER NUMBER

1773

DATE MAILED: 05/30/2002

8

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/633,911

Applicant(s)

MCGURRAN ET AL.

Examiner

Christopher G. Paulraj

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-59 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4, 6. 6) ☐ Other:

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 59 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim starts out with "[a] color-stable, pigmented optical body" but then goes on to recite "a method comprising . . ." and various steps. It is not clear whether Applicants are intending to claim a product made by the recited process steps (product-by process claim) or a process of making the color-stable, pigmented optical body.

3. Claim 56 recites the limitation "contrast enhancement film" in the second line. There is insufficient antecedent basis for this limitation in the claim because the parent claim 32 makes no reference to any contrast enhancement film.

4. Claims 28 and 56 recite that the display device has an external viewing surface that is "configured to comprise" the contrast enhancement. It is not clear whether the phrase "configured to comprise" requires the display device to actually comprise the contrast enhancement film or if it is simply a limitation on the configuration of the external viewing surface of the display device and does not necessarily require the optical body of the parent claim.

***Claim Rejections - 35 USC § 102/103***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 4-10, 12-17, 21-27, 29-32, 35-45, 49-55, and 57-59 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Fukuda et al. (U.S. Patent 4,865,898).

Fukuda et al. discloses a biaxially oriented polyester film containing uniformly carbon black particles and have a surface roughness Ra of between 3 and 25 nm (abstract). The composition can additionally contain additional inert inorganic particles such as calcium carbonate (col. 4, lines 60-65). The polyester film can be made using terephthalate or naphthalate monomer units (col. 3, lines 20-21). The carbon black particles can be present in the film in an amount of 0.05 to 5% and have particle size of 10 to 30 nm (col. 3, line 65, col. 4, line 5-6).

Although Fukuda et al. does not specify the light transmission of the polyester film within the visible spectrum or the haze levels, the Examiner takes the position that the claimed properties will be inherently met in the film of Fukuda et al. because the

exact same materials are disclosed in the same amounts as those taught in the instant specification. "Products of identical chemical composition can not have mutually exclusive properties." A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Alternatively, in the absence of showing unexpected results, one skilled in the art would have found it obvious to optimize the amounts of the polyester and the carbon black of Fukuda et al. to produce a film meeting the claimed transmission and haze levels. The motivation for doing so would have been to improve the light shielding properties of the film. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

The recitations in claims 22-27, 29-30, and 49-55 are directed towards the intended use of the optical body and are not patentably distinct over the prior art film of Fukuda et al. The determination of whether preamble recitations are structural limitations or mere statements of purpose or use "can be resolved only on review of the entirety of the [record] to gain an understanding of what the inventors actually invented and intended to encompass by the claim." Corning Glass Works, 868 F.2d at 1257, 9 USPQ2d at 1966. If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the

claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction. Pitney Bowes, Inc. v. Hewlett-Packard Co., 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999). See also Rowe v. Dror, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997) ("where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation").

8. Claims 1, 4, 6, 9, 21-27, and 29-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Wypart et al. (U.S. Patent 4,751,118).

Wypart et al. discloses a clear PVC article which comprises pigments and has a light transmission between 10 and 90% and a haze level as low as 2.23% (see col. 9-10, Table 1, ex. 22). The pigments can include calcium stearate and zinc stearate (Table 1). The recitations in claims 22-27, and 29-30 are directed towards the intended use of the optical body and are not patentably distinct over the prior art film of Wypart et al. for the reasons explained above.

The recitations in claims 22-27, and 29-30 are directed towards the intended use of the optical body and are not patentably distinct over the prior art film of Wypart et al.

9. Claims 1-6, 9-36, 39, 40, 42-56, and 59 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wheatley et al. (U.S. Patent 6,049,419).

Wheatley et al. discloses a multi-layer optical body which has an average light transmittance of between 10 and 90% (see fig. 1). At least one of the layers can include pigment, which can be an azo dye among others (col. 26, line 34). The polymeric

materials used in the layers can include polyethylene terephthalate and polyethylene naphthalate (col. 14, lines 14-18). The multi-layer stack can be oriented (col. 8, line 29). The film can be used in a display device (col. 32, line 54). The pigments can be used in the layers in an amount of 0.05 to about 0.5 wt. % of the optical body and preferably have a small particle size less than the wavelength of light ( $<380$  nm) (col. 27, lines 56).

Although Wheatley et al. does not specify the haze levels of multi-layer film, the Examiner takes the position that the claimed properties will be inherently met in the film of Wheatley et al. because the exact same materials are disclosed in the same amounts as those taught in the instant specification. See the reasons explained in the rejections above. Alternatively, in the absence of showing unexpected results, one skilled in the art would have found it obvious to optimize the amounts of the resin and the pigments in the film of Wheatley et al. to produce a film meeting the claimed haze levels. The motivation for doing so would have been to improve the reflecting properties of the film.

The recitations in claims 22-27, 29-30, and 49-55 are directed towards the intended use of the optical body and are not patentably distinct over the prior art film of Wheatley et al.

10. Claims 1, 4-6, 8-14, 16, 21-27, 29-32, 39-44, 49-55, 57, and 59 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Pengilly (U.S. Patent 4,408,004).

Pengilly discloses a high clarity, low haze polyester film that comprises carbon black particles (abstract). The film has a Hunter haze level of preferably less than 2.0 (col. 3, lines 40-43). The film can include additional bluing agents and pigments such

as antimony trioxide (col. 55-65). The polyester can be polyethylene terephthalate (col. 6, line 48). The particle size of the carbon black can range from 10 to 500 nm (col. 4, lines 19-20).

Although Pengilly does not specify the transmission levels of polyester film, the Examiner takes the position that the claimed properties will be inherently met in the film of Pengilly because the exact same materials are disclosed as those taught in the instant specification. See the reasons explained in the rejections above. Alternatively, in the absence of showing unexpected results, one skilled in the art would have found it obvious to optimize the amounts of the resin and the pigments in the film of Pengilly to produce a film meeting the claimed haze levels. The motivation for doing so would have been to improve the reflecting properties of the film. Pengilly does not specifically disclose that carbon black can be present in the concentration required by claim 32. However, in the absence of establishing unexpected results, one skilled in the art would have found it obvious to adjust the amounts to meet the claim requirements. The motivation for doing so would have been to optimize the clarity and the haze of the polyester.

The recitations in claims 22-27, 29-30, and 49-55 are directed towards the intended use of the optical body and are not patentably distinct over the prior art film of Pengilly.



***Information Disclosure Statement***

11. Receipt of Information Disclosure Statement filed on August 8, 2000 and May 1, 2001 is acknowledged and has been made of record. Foreign language documents were only considered to the extent of what their English abstracts provided.


***Conclusion***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher G. Paulraj whose telephone number is (703) 308-1036. The examiner can normally be reached on Monday-Friday, 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine Copenheaver can be reached on (703) 308-1261. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-0661.

cgp  
May 28, 2002

  
Paul Thibodeau  
Supervisory Patent Examiner  
Technology Center 1700